

Remarks

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

Claim Status

Upon entry of the foregoing amendments, claims 8-13, 56, and 70-75 are pending in the application, with claim 8 being the independent claim. Claims 1-7, 14-55, and 57-69 were previously cancelled. Claims 8 and 56 are currently amended. Support for the claim amendments can be found throughout the Specification. See, for example, at page 13, first paragraph and in the Examples. Thus, no new matter is added by way of these amendments, and their entry is respectfully requested.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 8-13, 56 and 70-75 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

First, the Action states that “there is no antecedent basis for ‘the crude preparation.’” Second, the Action states that “it is unclear as to whether the references ‘with’ is intended to characterize what is ‘mixed’ or the preparation itself.”

Without acquiescing to this rejection, and solely for the purpose of expediting allowance, Applicants have amended claim 8 to provide appropriate antecedent basis for “crude preparation” and to recite the step of “adding to said crude preparation” instead of “mixing the preparation with.”

Thus, in light of the aforementioned amendments, the rejection of independent claim 8 under 35 U.S.C. § 112, second paragraph is therefore moot and Applicant respectfully requests that the rejection of claims 8-13, 56 and 70-75 be withdrawn accordingly.

Rejection Under 35 U.S.C. § 102(b)

An anticipation rejection under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. See *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). See also M.P.E.P. 8th ed., § 2131 (rev. 2, May 2004) ("To anticipate a claim, the reference must teach every element of the claim.").

The present claims are drawn to a method for synthesizing a nucleic acid molecule from a crude preparation containing RNA and double-stranded DNA. The claimed method comprises:

- a) adding to the crude preparation one or more DNA polymerases, and one or more peptides or polypeptides having ribonuclease activity, wherein the peptides or polypeptides having ribonuclease activity are capable of degrading single-stranded RNA; and
- b) incubating the mixture under conditions sufficient to synthesize a nucleic acid molecule complementary to all or a portion of the double-stranded DNA and under which the peptides or polypeptides having ribonuclease activity degrade the single-stranded RNA.

I. The Major Reference:

Claims 8-13, 56 and 70-75 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Major *et al.*, *Biotechniques* 12:40-43 (1992), ("Major") as evidenced by Deana and Belasco, *Mol.*

Microbiol. 51:1205-1217 (2004) and O'Donnell, *Journal of Biological Chemistry*, 262 (34):16558-16565 (1987). Applicant respectfully traverses this rejection.

The Major reference does not teach a method that includes all of the steps encompassed by the currently presented claims. In particular, Major does not disclose the step of adding one or more DNA polymerases and one or more peptides or polypeptides having ribonuclease activity to a crude nucleic acid preparation. Rather, Major discloses adding a DNA polymerase, but not a peptide or polypeptide having ribonuclease activity, to a nucleic acid preparation. For at least this reason, Applicant requests that the rejection of claims 8-13, 56 and 70-75 under 35 U.S.C. § 102(b) as being anticipated by Major *et al.* be withdrawn accordingly.

II. The Maudru Reference:

Claims 8-13, 56 and 70-75 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Maudru *et al.*, *Journal of Virological Methods*, 66:247-261 (July 1997). Applicant respectfully traverses this rejection.

The Maudru reference does not teach a method that includes all of the steps encompassed by the currently presented claims. In particular, Maudru does not disclose the step of adding one or more DNA polymerases and one or more peptides or polypeptides having ribonuclease activity to a nucleic acid preparation comprising RNA and double-stranded DNA. Instead, Maudru teaches adding RNase and DNA polymerase to the products of RT reactions (*i.e.*, reactions comprising cDNA). (See Maudru Abstract and at page 250, section 2.2.2.) The resultant single-stranded cDNA of Maudru's RT "preparations" requires further conversion by DNA polymerase before becoming double stranded DNA. Because Maudru's addition of RNase and DNA polymerase is done "prior to

amplifying the cDNA product,” Maudru’s preparations do not already comprise double-stranded DNA at the time of addition. (See *Id* - emphasis added.) Thus, Maudru does not teach adding DNA polymerase and RNase to nucleic acid preparations containing double-stranded DNA. For at least this reason, Applicant respectfully requests that the rejection of claims 8-13, 56 and 70-75 under 35 U.S.C. § 102(b) as being anticipated by Maudru, *et al.* be withdrawn accordingly.

Conclusion

Applicants believe that a full and complete reply has been made to the Office Action dated January 9, 2009 and that the pending claims are in condition for immediate allowance. If the Examiner feels for any reason that additional discussion is necessary, Applicant invites the Examiner to call the undersigned directly at the number listed below.

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Respectfully submitted,

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